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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/896,653	06/29/2001	Douglas Calaway	10066-28550	8529

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EXAMINER

LAMB, TWYLER MARIE

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/896,653

Applicant(s)

CALAWAY, DOUGLAS

Examiner

Twyler M. Lamb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


TWYLER LAMB
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4, 5.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1, 3-13, 15-24, 27-32 and 38-43 are rejected under 35 U.S.C. 102(e) as being anticipated by Chui et al. (Chui) (US 6,657,702).

With regard to claims 1 and 25, Chui discloses a method for processing and printing electronic images on a medium comprising the steps of: a) receiving an electronic image file (col 10, lines 45-51); b) associating identification information with

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the electronic image file (col 14, lines 15-20); c) generating a composite image file, wherein the composite image file includes the electronic image file and the identification information (col 14, lines 34-38); d) printing the composite image from the composite image file on a medium, the composite image including an image and a first symbol, the first to symbol including the identification information (col 14, lines 34-38); e) extracting the identification information from the first symbol (col 14, lines 20-23); and f) printing the identification information read from the first symbol on the medium (col 14, lines 34-38).

With regard to claims 3 and 15, Chui also discloses wherein the identification information includes an order number and an image number (col 14, lines 15-20).

With regard to claims 4 and 16, Chui also discloses wherein the identification information is used to retrieve annotation information, the annotation information then being printed on the medium (col 14, lines 15-38).

With regard to claims 5, 17, 28 and 39, Chui also discloses wherein the identification information includes annotation information (col 14, lines 15-20).

With regard to claims 6, 18, 29 and 40, Chui also discloses wherein the first symbol is an optically readable barcode (Figure 9, barcode 910, col 21, lines 40-51).

With regard to claims 7, 19, 30 and 41, Chui also discloses wherein the printed identification information includes a second symbol (col 14, lines 15-20).

With regard to claims 8 and 20, Chui also discloses wherein the step of printing the composite image includes exposing the medium and chemically developing the image (col 14, lines 34-38; lines 59-65).

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With regard to claims 9 and 21, Chui also discloses wherein the step of printing the second symbol occurs after the medium has been chemically processed (col 1, lines 43-48; col 13, lines 12-21).

With regard to claims 10 and 22, Chui also discloses wherein the composite image is printed on a photosensitive surface of the medium and the identification information is printed on the image reverse (col 14, lines 15-20).

With regard to claims 11 and 23, Chui also discloses wherein the first symbol is read with an optical scanner (col 1, lines 43-48; col 2, lines 13-28; col 12, lines 39-51).

With regard to claims 12 and 24, Chui also discloses further comprising the step of assembling an order, wherein the step of assembling an order includes the steps of: separating the first symbol from the medium for the composite image; separating the image from the medium; collecting one or more images having associated identification information; and shipping the collected images to an address associated with the customer number (col 14, line 66 – col 17, line 63).

With regard to claim 13, Chui discloses a method for processing and printing electronic images on a medium comprising the steps of: a) receiving an electronic image file (col 10, lines 45-51); b) associating identification information with the electronic image file (col 14, lines 15-20); c) generating a composite image file, wherein the composite image file includes the electronic image file and the identification information (col 14, lines 34-38); d) printing the composite image from the composite image file on a medium, the composite image including an image and a first symbol, the first to symbol including the identification information (col 14, lines 34-38); e) extracting

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the identification information from the first symbol (col 14, lines 20-23); and f) printing the identification information read from the first symbol on the medium (col 14, lines 34-38); and g) separating the first symbol from the medium for the composite image (col 15, line 31 – col 17, line 63).

With regard to claims 27 and 38, Chui also discloses wherein the identification information includes an order number and a customer number (col 14, lines 15-20).

With regard to claims 31 and 42, Chui also discloses wherein the means for reading the plurality of first barcodes is an optical scanner (Figure 9, barcode 910, col 21, lines 40-51; col 1, lines 43-48).

With regard to claims 32 and 43, Chui also discloses wherein the means for printing the information is an ink jet print-head (which reads on printing with any physical manifestation being printed by an inkjet printer) (col 1, lines 58-62; col 14, lines 59-65).

4. Claims 25, 33-36 and 44 are rejected under 35 U.S.C. 102(e) as being anticipated by Redd et al. (Redd) (US 6,646,754).

With regard to claim 25, Redd discloses an annotation printer apparatus (print lab system 600) for processing images on a medium and printing information thereon comprising: a) means (barcode reader 633, 636) for reading a plurality of first symbols existing on the medium, wherein each of the first symbols corresponds to one of a plurality of images existing on the medium, the first symbol including identification information (col 21, lines 61-65; col 26, lines 9-55); b) means (printer 622, backprinter

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634) for printing identification information read from each of the first symbols, wherein the identification information read from each of the first symbols is printed proximate to the image and first symbol to which it corresponds (col 17, line 51 – col 18, line 15; col 26, lines 30-36); and C) means (scheduler 608) for regulating movement of the medium through the apparatus to coordinate the reading of each first symbol and the printing of each second symbol (col 19, line 26 – col 20, line 33).

With regard to claim 33, Redd also discloses wherein the means for regulating the movement of the medium through the apparatus includes a computer, wherein the computer is connected to sensors for sensing the speed the medium moves through the apparatus, for determining when the printing means prints the information so that the information is printed proximate to the corresponding image (col 19, line 26 – col 20, line 33).

With regard to claim 34, Redd also discloses wherein the means for regulating the movement of the medium through the apparatus further comprises: an electric motor with an attached drive pulley, the speed of which is regulated by the computer based on the sensed speed of the medium, for motivating the medium; and a drive system including a plurality of pulleys, wherein a separate pulley is attached to the motor, a supply spool, a take-up spool, and two capstans, the pulleys driven by a plurality of belts attached to the drive pulley of the motor (col 25, line 43 – col 26, line 8).

With regard to claim 35, Redd also discloses wherein the computer (computer system 100; 320) is adapted to communicate with a server computer via a network, for retrieving an annotation associated with the identification information read from the first

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bar code, the computer further adapted to cause the printing means to print the annotation on the medium proximate to the composite image to which it corresponds (col 3, lines 11-29; col 10, lines 32-49).

With regard to claims 36 and 44, Redd discloses an annotation printer apparatus (print lab system 600) for processing images on a medium and printing information thereon comprising: a) means (barcode reader 633, 636) for reading a plurality of first symbols existing on the medium, wherein each of the first symbols corresponds to one of a plurality of images existing on the medium, the first symbol including identification information (col 21, lines 61-65; col 26, lines 9-55); b) means (printer 622, backprinter 634) for printing identification information read from each of the first symbols, wherein the identification information read from each of the first symbols is printed proximate to the image and first symbol to which it corresponds (col 17, line 51 – col 18, line 15; col 26, lines 30-36); and c) means (scheduler 608) for regulating movement of the medium through the apparatus to coordinate the reading of each first symbol and the printing of each second symbol (col 19, line 26 – col 20, line 33), wherein the means for regulating includes a computer, the being computer connected to sensors rigidly attached to the table, for sensing the speed the medium moves through the apparatus to determine when the printing means prints the information so that the information is printed proximate to the image to which it corresponds (col 19, line 26 – col 20, line 33), ii) an electric motor having an output shaft, the speed of the output shaft being regulated by the computer based on the sensed speed of the medium, for motivating the medium (col

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25, line 43 – col 26, line 8), and iii) a drive system means adapted to transfer rotational motion of the output shaft to a supply spool, a take-up spool, and two capstans Simultaneously (col 24, lines 7-51); and wherein the computer is configured to communicate with a server computer to receive identification information therefrom, the identification information corresponding to information read from each of the first symbols (col 3, lines 11-29; col 10, lines 32-49).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 14, 26 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chui et al. (Chui) (US 6,657,702) in view of Redd et al. (Redd) (US 6,646,754).

With regard to claims 2, 14, 26 and 37, Chui also discloses wherein the medium is printed, but it does not clearly teach that the medium is a continuous roll of photographic paper.

Redd discloses a system for backprinting image prints wherein the medium is a continuous roll of photographic paper (Figure 12, col 21, lines 38-42).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Chui to include the print medium being a continuous

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roll of photographic paper as taught by Redd. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Chui by the teaching of Redd to allow successive printing onto successive portions of a roll of print paper as taught by Redd in col 21, lines 38-42.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Twyler Lamb whose telephone number is 703 - 308-8823. The examiner can normally be reached on M-TH (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L Coles can be reached on 703-308-4712. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9314 for After Final communications.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

or faxed to:

(703) 872-9314

(for informal or draft communications, such as proposed amendments to be discussed at an interview; please label such communications "PROPOSED" or "DRAFT")

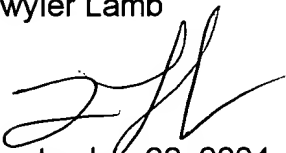
or hand-carried to:

Crystal Park Two
2121 Crystal Drive
Arlington, VA.
Sixth Floor (Receptionist)

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Twyler Lamb

A handwritten signature in black ink, appearing to be 'T. Lamb', written over the date.

September 20, 2004